



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/518,742

07/26/2005

Ulrike Wachendorff-Neumann

2400.0250001/RWE/L-Z

3030

26111

7590

08/17/2010

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LEVY, NEIL S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

08/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,742	Applicant(s) WACHENDORFF-NEUMANN ET AL.	
	Examiner NEIL LEVY	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 12-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/28/2010</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Change in inventorship will be done.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Voluminous references of over 400 pages are considered as they would be in a standard office key word search. Note is taken of the Protest, but it appears to not be of the instant invention. Examiner fails to appreciate the relevance. The office actions of other examiners also is not understood as to their relevance to this case. The cited patents and priority documents are seen as cumulative to examiner's submissions if record in this application, & are not seen as subjects of double patenting concerns. However, some of the documentation was in German, which I do not understand, & thus can not review and comment on. The English portions were not readily determinable as to their relationship to the German, nor were they identifiable as to their relevance to examination of this case. Attorney had made no comment or explanation of any of the submitted documents.

Claim 10 is in status "currently amended" but examiner can not see any addition or deletion. I believe correct status is "previously presented."

Claim Rejections - 35 USC § 103

Claims 6-10,12-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over ZIMMERMAN-7179824

ZIMMERMAN presents compounds & compositions (col. 29,30)to control insects & with the instant methods of application (col. 35) in combination with additional fungicides(col. 32, Lines 44-57), inclusive of prothioconazole & trifloxystrobin(col. 33, llines 41,45) .

The agent of ZIMMERMAN is to be formulated with AT LEAST one more bioactive agent (col 32, lines 55-58; col 33, lines 41, 45). One in the art would find it obvious to try at least a 1:1:1 resulting in instant (I) to (II) within the ranges of claims 6, 7, 10, 12, and 14. Application rates are shown as 0.01-2kg/ha, meeting the instant claims 15-19 (col 35, lines 53-61).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize combination pest control means, modified as desired to increase the range of toxicity to include fungus along with insect control.

All the critical elements of the instant are disclosed. The amounts and proportions of each ingredient are result effective parameters chosen to obtain the desired effects. It would be obvious to vary the form of each ingredient to optimize the effect desired, depending upon the particular species and application method of interest, reduction of toxicity, cost minimization, enhanced, and prolonged, or synergistic effects.

As the instant application requires one to perform experimentation to determine synergy, it would likewise be obvious to the peruser of ZIMMERMAN to test the combinations as indicated to optimize that combination of greatest efficacy for the

immediate pest and treatment loci or plant of concern. These added compounds only improve the general character and effects of the ZIMMERMAN compositions, and of the instant if inclusive of the ZIMMERMAN formula I compound, as so indicated at column 32, lines 44-57 to extend the spectrum of utility.

Applicant's arguments filed 5/28/2010 have been fully considered but they are not persuasive. Applicants argue ZIMMERMAN does not provide a reason to combine instant compounds of I and II, and further argue the instant compositions are not pesticidal. ZIMMERMAN does include a specific list of a limited number of compounds, for combination with the new compounds, and there are fungicides. The range would be extended, by such application of the number of pests to thus be controlled. Such combination would be known by one in the art to test with expectation of success with either the range of pest species controlled or better results, or both.

Claims 6-10,12-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over ISENRING et. al. (United States Patent 6,407,100), JAUTELAT et al (US Patent 5,789,430).

These references teach the compounds trifloxystrobin, prothioconazole as antimicrobial agents, which embraces Applicant's claimed invention.

Art Unit: 1615

ISENRING teaches trifloxystrobin as fungicide. See the entire document especially lines 10-20 in column 1, lines 34-67 in column 6, abstract, and examples. See Example 24, Table 2 and formulation F1 of methylpyrrolidone solvent and non-ionic surfactant; the instant trifloxystrobin antifungal and carriers, to treat plants (example B2-B7).

JAUTELAT teaches prothioconazole and tebuconazoles as microbicides.

See the entire document especially example 1 in column 35, lines 27-64 in column 29, lines 1-55 in column 30 and Table 1 in column 14. : see Example 1, tautomer of prothioconazole, as antifungal in carriers of ISENRING & the instant, at Example E

See column 31, 32 mixing and adjuvants with other fungicides is presented. Application is at the instant level (column 34, lines 27-60) and determinable by artisan. One would expect an enhanced effect by application of two fungicides, an increased range of fungi species controlled and/or a decreased concentration of one or both fungicides. One would be able to determine the ratio of the two fungicides, as exemplified by each reference, by simple testing with expectation of success in identifying optimal ratio to control the fungus desired.

Instant claims differ from the reference in claiming the combination of both known compounds useful as antimicrobial and antifungal agents.

It would have been obvious to one skilled in the art at the time of invention was made to combine known compounds for the same purpose in expectation to improve efficacy. Since The above cited reference teach the active compounds as claimed it is prima facie obvious to combine two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a new composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069.

JANTELAT shows prothioconazole as fungicidal, in formulations at 0.1-95% with the usual carriers and extenders (col 31, line 29-line 23, col 32.) They are applied to plants, seeds and soil (col 34, lines 27-60) with other fungicides, bactericides, insecticides (lines 60-67, col 34.)

Such fungicides include the ISERING trifloxystrobin, shown effective in various samples B2-B7.

JANTELAT shows the prothioconazole able to control fusarium (Table 1) E-1 on wheat. ISERING shows trifloxystrobin controls, when applied to plants, seeds, and soil, erysiphe on wheat (Example B3). Both references apply at the instant concentrations.

Applicant's arguments that in re KERKHOVEN is far removed are not persuasive.

Applicant has provided no objective showing of unobvious or unexpected results.

Claims 6-10,12-19 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over BERGER et al US2004/0209923

Plants are protected with mixes of actives [0001] applied to plant parts and soil [0028]. Formulations are shown to include surfactants [0255-0257] and the instant fungicides-one or more [0259]. Seed coatings are shown-1.75-0.15% active.

See claim 22.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize combination pest control means, to use BERGER modified as desired to increase the range of toxicity to include fungus along with insect control.

Applicant's arguments filed 5/28/2010 have been fully considered but they are not persuasive. applicant argues the references require other compounds , and are pesticidal, while applicant's is fungicidal, & do not show the instant ratios.

We find the pesticidal compositions and methods instantly claimed to also be shown by the instant , & other , compounds & combinations thereof; the combinations are stated to be effective, data supporting is evident in the prior art, as is the concentrations of the mixtures. precludes other compounds; it does not, because the primary compound of each reference does not interfere with the pesticidal functions of the instant claim; they add to them, whether as enhancers or synergists with fungicidal function, or as extending the pesticidal range of pests controllable to include, fungus, molds, bacteria, nematodes, insects, acarids, & other pests. Many references, inclusive of some of those

of the Protest & IDS show 3 or more pesticides mixed together to achieve improved or enhanced, synergistic, effects, inclusive of current inventors' patents. Applicant's arguments that the test results are synergistic & unexpected are not persuasive, since the cited art also argues for synergistic results, therefore, expected. Further, the synergy, one would expect to find as an order of magnitude difference, is seen only as presented in terms of the Colby herbicidal combinations. However, this form of the synergistic effects are not so claimed.

If they were, and as methods limited to wheat treated with compositions consisting of I and II at a ratio of 1:0.05-1:10, at 1-1000gm/ha they would be seen as overcoming the prior art of record. Limitation to treating with compositions consisting of I and II at a ratio of 1:0.05-1:10, according to claim 14 at the same rates to control leptosphaeria and puccinia would also be seen as overcoming the art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1615

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT A. WAX can be reached on 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NEIL LEVY/
Primary Examiner, Art Unit 1615

8/13/2010